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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ann M. Stawski

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EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3686

NOTIFICATION DATE

DELIVERY MODE

12/11/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

e-OfficeActionBSC@faegre.com

Office Action Summary	Application No. 10/789,788	Applicant(s) STAWSKI ET AL.	
	Examiner LENA NAJARIAN	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7-11,13,19-21,23-25,27-32 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7-11,13,19-21,23-25,27-32 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040726;20051014;20080208</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 34, 35, and 36 are objected to because of the following informalities: they depend on cancelled claim 33. Appropriate correction is required.
2. Claim 29 is objected to because of the following informalities: line 7 contains unclear language ("for the plurality for the single"). Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 7-11, 13, 19-21, 23, 25, 27-32, and 35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman, Jr. et al. (6,012,035).

(A) Referring to claim 1, Freeman discloses a system for processing reimbursements to physicians for participating in a medical study, comprising:

a microprocessor-based controller; and a computer readable medium, including instructions executable by the microprocessor-base controller to (Fig. 1-2 and col. 4, lines 13-24 of Freeman):

receive patient medical information from a physician relating to the medical study (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman);

automatically validate the patient medical information (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman);

upon validating the patient medical information, store a reimbursement record in a database, the reimbursement record indicating at least a reimbursement amount and the physician to be reimbursed (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman); and

automatically process at least one reimbursement to each physician having one or more reimbursement records in the database (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman).

(B) Referring to claim 2, Freeman discloses wherein the patient medical information is patient diagnosis information (col. 8, lines 14-20 of Freeman).

Insofar as the claim recites "selected from the group consisting of," it is immaterial whether or not the other elements are also disclosed.

(C) Referring to claim 3, Freeman discloses wherein the database includes a plurality of reimbursement records, and wherein the computer readable medium further includes instructions executable by the microprocessor-based controller to: group at least some of the plurality of reimbursement records into a single reimbursement file; and provide to an approval authority access to the reimbursement file (Fig. 4 and col. 8, line 54 - col. 9, line 15 of Freeman).

(D) Referring to claim 5, Freeman discloses wherein the reimbursement file is electronically forwarded to the approval authority (col. 8, lines 14-36 of Freeman).

(E) Referring to claim 7, Freeman discloses wherein the computer readable medium further includes instructions executable by the microprocessor-based controller to: process reimbursements to the physicians upon approval by the approval authority (col. 8, lines 14-36 of Freeman).

(F) Referring to claim 8, Freeman discloses wherein the computer readable medium further includes instructions executable by the microprocessor-based controller to: electronically transmit the reimbursement file to an accounting system adapted to process the reimbursements to the physicians upon approval by the approval authority (col. 4, lines 26-37 and col. 8, lines 14-36 of Freeman).

(G) Referring to claim 9, Freeman discloses wherein the database includes a plurality of reimbursement records associated with one physician, and wherein the computer readable medium further includes instructions executable by the microprocessor-based controller to: accumulate the plurality of reimbursement records for the one physician into a single reimbursement record for the physician; and process a single reimbursement for the single reimbursement record (col. 8, lines 54-67 and col. 8, lines 14-36 of Freeman).

(H) Referring to claim 10, Freeman discloses wherein the computer readable medium further includes instructions executable by the microprocessor-based controller to: accumulate a plurality of reimbursement records in the database for one or more physicians over a predetermined period of time; and process one or more

reimbursements to each of the one or more physicians at the end of the predetermined period of time (col. 2, lines 50-64 and col. 8, lines 27-28 of Freeman).

(I) Claims 11, 13, 19 and 20 repeat substantially the same limitations as claims 1, 3, 9, and 10, and are rejected for the same reasons given above.

(J) Referring to claim 21, Freeman discloses a system for processing reimbursements to physicians for participating in one or more medical studies, wherein the one or more medical studies require physicians to perform procedures on one or more patients, the system comprising:

a microprocessor-based controller; a computer readable medium, wherein the computer readable medium includes instructions executable by the microprocessor-based controller to (Fig. 1-2 and col. 4, lines 13-24 of Freeman):

receive medical procedure information from one or more physicians for each procedure performed by the one or more physicians on the one or more patients in the medical study; automatically validate the medical procedure information (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman);

upon validating the medical procedure information, store a reimbursement record in a database for each procedure, the reimbursement record indicating at least a reimbursement amount and the physician to be reimbursed (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman); and

automatically process at least one reimbursement to each physician having one or more reimbursement records in the database (Fig. 3, col. 2, lines 26-64, and col. 18, lines 14-26 of Freeman).

(K) Claims 23, 25, 27-30, 31, 32, and 35 repeat substantially the same limitations as claims 3, 5, 7-10, 21, 2, and 5, respectively, and are therefore rejected for the same reasons given above.

(L) Referring to claim 36, Freeman discloses further comprising the approval authority approving the reimbursement records for reimbursement reimbursements electronically (col. 8, lines 14-36 of Freeman).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 24 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman, Jr. et al. (6,012,035).

(A) Referring to claim 24, Freeman discloses keeping reimbursement transaction information in a repository having the at least some of the reimbursement records listed therein (see col. 2, lines 44-64 of Freeman).

Freeman does not expressly disclose that the reimbursement file comprises a *spreadsheet*. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a spreadsheet with the motivation of organizing the data to allow for analysis.

(B) Claim 34 repeats the same limitations as claim 24, and is therefore rejected for the same reasons given above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches electronic creation, submission, adjudication, and payment of health insurance claims (US 6,343,271 B1); a health care administration method (US 2005/0010436 A1); systems and methods for obtaining approval for medical reimbursements (US 2002/0082863 A1); patient data mining for clinical trials (US 2003/0130871 A1); a system and method for processing and managing claim forms (US 2004/0249665 A1); a method and system for dispensing, tracking and managing pharmaceutical trial products (5,832,449).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/L. N./
Examiner, Art Unit 3686
In
12/2/08

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686